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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/535,348	03/24/2000	Gang Sun	18062G-003000US	3172

20350 7590 10/31/2003

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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 10/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/535,348	<b>Applicant(s)</b> SUN ET AL.	
	<b>Examiner</b> Laura L. Stockton, Ph.D.	<b>Art Unit</b> 1626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,6,8,12,13 and 57-66 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 59-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6 and 8 is/are rejected.
- 7) ☒ Claim(s) 13,57 and 58 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

**Claims 1, 6, 8, 12, 13 and 57-66 are pending in the application.**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 3, 2003 has been entered.

### ***Election/Restrictions***

Applicants' election with traverse of Group I on page 11 in the response filed July 8, 2002 has been acknowledged previously. The requirement was deemed proper and made FINAL previously.

In the amendment filed October 3, 2003, Applicants have amended the claims and therefore, the previous cited prior art has been overcome. Applicants have also elected a new species, BADDD found on page 7, lines 14-15, for examination. No prior art was found for the new elected species of BADDD and therefore, the search was expanded. Since art was found on the expanded embodiment {e.g.,  $R^1$  and  $R^2$  and the carbon to which they are bound join to form a carboxylic ring; Q is NH, and Z is  $CH_2$ }, the search was stopped. Note, M.P.E.P. § 803.02.

The claims that are readable on the expanded embodiment are 1, 6, 8, 13, 57 and 58.

Subject matter not embraced by the elected species of BADDD or the above expanded examined embodiment and claims 12 and 59-66 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions. Applicant timely traversed the restriction (election) requirement in the response filed July 8, 2002.

Rejections made in the previous Office Action that do not appear below have been overcome by the amendment to the claims. Therefore, these rejections will not be addressed. However, the following now applies.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Pedregal et al. {Journal of Heterocyclic Chemistry (March-April 1984), 21(2), pages 477-480}.

Pedregal et al. disclose the compound of 2d in Scheme 1 on page 477 or in Table 1 on page 478 (CA Registry No. 882-66-6) which is embraced by the instant claimed invention.

Claims 1, 6, 8, 13, 57 and 58 have been examined to the extent that the expanded embodiment is embraced by these claims. All other subject matter in these claims has not been examined.

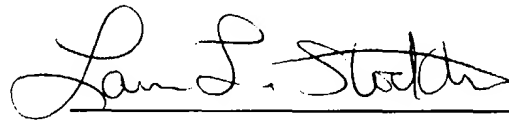
*Allowable Subject Matter*

Claims 13, 57 and 58 are objected to as being dependent upon a rejected base claim, but would be allowable if: (1) rewritten in independent form including all of the limitations of the base claim and any intervening claims; and (2) directed solely toward the expanded examined embodiment indicated above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

A handwritten signature in cursive script, reading "Laura L. Stockton", written in black ink.

Laura L. Stockton, Ph.D.  
Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600

October 24, 2003